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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/270,151 03/16/99 DEGABLI

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EXAMINER

QM12/0229

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SUITE 3605
NORTHFIELD IL 60093

PRYOR, S

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

02/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/270,151

Applicant(s)

Degabli

Examiner

Sean Pryor

Group Art Unit

3724



☒ Responsive to communication(s) filed on Mar 16, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

2. The disclosure is objected to because of the following informalities: on pg. 7, line 14, --36-- should be inserted after "tab".

Appropriate correction is required.

Claim Objections

3. Claim 3 is objected to because of the following informalities: the two period punctuation ".." should read --.-- (line 2). Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It appears that this claim is a method claim with steps, therefore the use of the term "means" (line 1) is unclear. Perhaps "means" should read --method--? Furthermore, claim 6 is unclear since it does not recite a step and appears to actually depend from claim 5 instead of claim 4. For the purposes of this action only, claim 6 will be treated as dependent from claim 5 accordingly. The recitation of "a hook in each half of the housing" (cl. 1, line 6) is indefinite. Is

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this one hook in both halves or a first hook in a first half and a second hook in a second half? The recitation of "a hook in each side of the housing" (cl. 5, line 2) is indefinite for similar reasons as mentioned above. The recitation of "wherein the tape extends laterally" is indefinite. Which way is laterally?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-6, as can be understood, ^{are} rejected under 35 U.S.C. 103(a) as being unpatentable over Mackie.

Mackie discloses a utility knife comprising: a separable two halve housing (at 14); a retractable blade (18); a tape measure with a ruler and tab in parallel alignment (Fig. 3 at 50, 54); and a hook located within the housing forming a space (Fig. 2 at 34, 36) and the hook can reversibly retain the measuring tape depending on one's relative frame of reference.

Mackie discloses the claimed invention except for hooks on each side of the housing. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide hooks on each side of the housing, since it has been held that mere duplication of the essential working parts of device involves only routine skill in the art. *St. Regis Paper Co. v.*

Bemis Co., 193 USPQ 8.

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Furthermore, applicant has not disclosed that the space having an open end located on the bottom surface of the utility knife near the blade solves any particular problem or presents any unexpected results, and it would appear that Mackie's closed end space near the blade would work just as well.

7. Claims 1-6, as can be understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackie in view of Coffey.

If it is found that a space with an open end located on the bottom surface of the utility knife does solve a particular problem or presents an unexpected result, then Coffey teaches that it is well known in the art to utilize space with an open end (Fig. 2 at 43) on a bottom surface of a utility knife. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have replaced Mackie's hook configuration with a space with an open end located on a bottom surface of the utility knife, as taught by Coffey, in order to more easily hook and unhook the tape measure.

Furthermore, Mackie, as modified, discloses the claimed invention except for hooks on each side of the housing. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide hooks on each side of the housing, since it has been held that mere duplication of the essential working parts of device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pelletier (which could be used as a 102 rejection), Bourque, Cornacchio et al., Beard, and Rowley are cited to show related devices.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Pryor whose telephone number is (703) 308-7601. The examiner can normally be reached on Monday through Friday from 7:45AM to 4:45PM. Examiner has every other Friday off (first Friday of the biweek).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.



KENNETH E. PETERSON
PRIMARY EXAMINER

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February 17, 2000